



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/922,182

08/02/2001

Gregory Maurice Plow

STL920000035US1

7553

63675

7590

08/26/2010

PATTERSON & SHERIDAN, LLP/IBM SVL
3040 POST OAK BLVD.
SUITE 1500
HOUSTON, TX 77056-6582

EXAMINER

MYHRE, JAMES W

ART UNIT

PAPER NUMBER

3688

MAIL DATE

DELIVERY MODE

08/26/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/922,182	Applicant(s) PLOW ET AL.	
	Examiner JAMES W. MYHRE	Art Unit 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6,13-16,18 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6, 13-16, 18, and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 8, 2010 has been entered.

Response to Amendment

2. This Office Action is in response to the Amendment filed on July 8, 2010. The Amendment did not add any new claims, but did cancel Claims 4 and 17 and amended Claims 1-3, 6, 13-16, 18, and 19. Claims 5, 7-12, and 20-22 were previously cancelled. Thus, the currently pending claims considered below are Claims 1-3, 6, 13-16, 18, and 19.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 13 recites the limitation "the saved banner advertisements" in line 13. There is insufficient antecedent basis for this limitation in the claim. The Examiner notes that the Amendment filed on July 8, 2010 removed the "operation for saving Internet advertisements". Thus, the claim as it stands now does not include any steps wherein the advertisements are saved, which is a crucial step for the invention. The Examiner will consider the claim to include this feature during prosecution below.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

Art Unit: 3688

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-3, 6, 13-16, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rice (6,486,891).

Claim 1: Rice discloses a method, comprising:

- a. receiving at a user's computer webpages comprising content and banner advertisements, each associated with a link to an advertiser's website, wherein the advertisements were not requested by the user ("the server responds to the page request by transmitting the requested page at step 320. One or more advertisements may be embedded within the requested page. Typically, the advertisements are selectable graphics, such as banner ads, tiles, or the like, and/or hypertext links") (Figure 3, item 320; column 2, lines 41-59; and column 4, line 65 – column 5, line 5);
- b. executing software code to automatically identify and save the banner advertisements and associated links ("Uniform Resource Locator (URL) of the home page of the advertiser is stored (e.g. bookmarked) in the user's web browser" including "a link to the advertisement itself") (Figure 3, item 350; column 2, lines 41-59; column 5, lines 6-55; and column 6, line 11 – column 7, line 23).

- c. providing an advertising history window for user-controlled scrolling through the banner advertisements saved from the web pages;
- d. receiving, via the advertising history window, user input selecting one of the banner advertisements saved from the web pages (selecting the bookmark button on the user's tool bar opens a small window and "presents a list of web pages that have been bookmarked and allows the user to select one or the saved web pages to retrieve"...the web page associated with the banner ad 530 is shown in the list of bookmarked web pages 590.")(Figure 5c, item 590; column 2, lines 41-59; and column 8, lines 1-7 and 39-41); and
- e. accessing, via the link associated with the selected banner advertisement, the target website identified by the link associated with the selected banner advertisement ("Subsequently, the user may view the source of the advertisement by selecting the previously created bookmark." (column 2, lines 28-30).

The Examiner notes that Rice discloses or at least implies that a first and second web page is received containing advertisements that the user may save by disclosing that the user may subsequently select the saved advertisements from the bookmarked list of saved advertisements, i.e. if there was only one saved advertisement from one web page, there would be no "list" of bookmarked advertisement. In any case, it still would have been obvious to one having ordinary skill in the art at the time the invention was made for Rice to run the automated bookmarking system more than once (i.e. for a plurality of web pages) in order to generate the bookmarked list.

While Rice discloses opening a small window (i.e. advertising history window) displaying the saved advertisements (or links thereto), it is not explicitly disclosed that the list is scrollable. However, Official Notice is taken that scrollable windows and lists have been an integral part of the Windows™ since its inception in the early 1990's. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Rice to allow the user to scroll through the list of bookmarked advertisements. One would have been motivated to include such a scrolling feature in order to allow a large number of advertisements to be bookmarked and perused without running off the bottom of the screen.

Claim 2: Rice discloses a method as in Claim 1 above, and further discloses the selected banner advertisement includes an HTML tag (column 3, lines 19-27).

Claim 3: Rice discloses a method as in Claim 1 above, and further discloses outputting a button for display ("Bookmark" button) that, when activated, causes the display of the selected bookmarked advertisement (Figures 5 and 6; Abstract; and column 7, line 66 – column 8, line 7).

Claim 6: Rice discloses a method as in Claim 1 above, and further discloses displaying one or more navigational buttons as part of the graphical user interface (GUI) (Figures 5 and 6; and column 7, line 66 – column 8, line 7). While Next and Previous buttons are not explicitly disclosed by Rice, Official Notice is taken that these were both well known

Art Unit: 3688

types of navigational buttons usually found on GUIs to enable the user to quickly go to the Next or Previous pages. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Rice to include Next and Previous buttons with the bookmark interface in order to allow the user to quickly and easily navigate between the saved advertisements.

Claim 13: Rice discloses a system, comprising:

- a. at least one user computer connected to a web server via the Internet (column 3, lines 29-59);
- b. the user computer receiving webpages comprising content and banner advertisements, each associated with a link to an advertiser's website, wherein the advertisements were not requested by the user ("the server responds to the page request by transmitting the requested page at step 320. One or more advertisements may be embedded within the requested page. Typically, the advertisements are selectable graphics, such as banner ads, tiles, or the like, and/or hypertext links") (Figure 3, item 320; column 2, lines 41-59; and column 4, line 65 – column 5, line 5);
- c. executing software code to automatically identify and save the banner advertisements and associated links ("Uniform Resource Locator (URL) of the home page of the advertiser is stored (e.g. bookmarked) in the user's web browser" including "a link to the advertisement itself") (Figure 3, item 350; column 2, lines 41-59; column 5, lines 6-55; and column 6, line 11 – column 7, line 23).

- d. providing an advertising history window for user-controlled scrolling through the banner advertisements saved from the web pages;
- e. receiving, via the advertising history window, user input selecting one of the banner advertisements saved from the web pages (selecting the bookmark button on the user's tool bar opens a small window and "presents a list of web pages that have been bookmarked and allows the user to select one or the saved web pages to retrieve"...the web page associated with the banner ad 530 is shown in the list of bookmarked web pages 590.")(Figure 5c, item 590; column 2, lines 41-59; and column 8, lines 1-7 and 39-41); and
- f. accessing, via the link associated with the selected banner advertisement, the target website identified by the link associated with the selected banner advertisement ("Subsequently, the user may view the source of the advertisement by selecting the previously created bookmark." (column 2, lines 28-30).

The Examiner notes that Rice discloses or at least implies that a first and second web page is received containing advertisements that the user may save by disclosing that the user may subsequently select the saved advertisements from the bookmarked list of saved advertisements, i.e. if there was only one saved advertisement from one web page, there would be no "list" of bookmarked advertisement. In any case, it still would have been obvious to one having ordinary skill in the art at the time the invention was made for Rice to run the automated bookmarking system more than once (i.e. for a plurality of web pages) in order to generate the bookmarked list.

Art Unit: 3688

While Rice discloses opening a small window (i.e. advertising history window) displaying the saved advertisements (or links thereto), it is not explicitly disclosed that the list is scrollable. However, Official Notice is taken that scrollable windows and lists have been an integral part of the Windows™ since its inception in the early 1990's. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Rice to allow the user to scroll through the list of bookmarked advertisements. One would have been motivated to include such a scrolling feature in order to allow a large number of advertisements to be bookmarked and perused without running off the bottom of the screen.

Rice further discloses displaying one or more navigational buttons as part of the graphical user interface (GUI) (Figures 5 and 6; and column 7, line 66 – column 8, line 7). While Next and Previous buttons are not explicitly disclosed by Rice, Official Notice is taken that these were both well known types of navigational buttons usually found on GUIs to enable the user to quickly go to the Next or Previous pages. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Rice to include Next and Previous buttons with the bookmark interface in order to allow the user to quickly and easily navigate between the saved advertisements.

Art Unit: 3688

Claim 14: Rice discloses a computer readable medium containing instructions that when executed by a computer processor performs the steps of:

a. receiving at a user's computer webpages comprising content and banner advertisements, each associated with a link to an advertiser's website, wherein the advertisements were not requested by the user ("the server responds to the page request by transmitting the requested page at step 320. One or more advertisements may be embedded within the requested page. Typically, the advertisements are selectable graphics, such as banner ads, tiles, or the like, and/or hypertext links") (Figure 3, item 320; column 2, lines 41-59; and column 4, line 65 – column 5, line 5);

b. identifying and saving the banner advertisements and associated links ("Uniform Resource Locator (URL) of the home page of the advertiser is stored (e.g. bookmarked) in the user's web browser" including "a link to the advertisement itself") (Figure 3, item 350; column 2, lines 41-59; column 5, lines 6-55; and column 6, line 11 – column 7, line 23).

c. providing an advertising history window for user-controlled scrolling through the banner advertisements saved from the web pages;

d. receiving, via the advertising history window, user input selecting one of the banner advertisements saved from the web pages (selecting the bookmark button on the user's tool bar opens a small window and "presents a list of web pages that have been bookmarked and allows the user to select one or the saved web pages to retrieve"... "the web page associated with the banner ad 530 is shown in the list of

Art Unit: 3688

bookmarked web pages 590.”)(Figure 5c, item 590; column 2, lines 41-59; and column 8, lines 1-7 and 39-41); and

e. accessing, via the link associated with the selected banner advertisement, the target website identified by the link associated with the selected banner advertisement (“Subsequently, the user may view the source of the advertisement by selecting the previously created bookmark.” (column 2, lines 28-30).

The Examiner notes that Rice discloses or at least implies that a first and second web page is received containing advertisements that the user may save by disclosing that the user may subsequently select the saved advertisements from the bookmarked list of saved advertisements, i.e. if there was only one saved advertisement from one web page, there would be no “list” of bookmarked advertisement. In any case, it still would have been obvious to one having ordinary skill in the art at the time the invention was made for Rice to run the automated bookmarking system more than once (i.e. for a plurality of web pages) in order to generate the bookmarked list.

While Rice discloses opening a small window (i.e. advertising history window) displaying the saved advertisements (or links thereto), it is not explicitly disclosed that the list is scrollable. However, Official Notice is taken that scrollable windows and lists have been an integral part of the Windows™ since its inception in the early 1990's. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Rice to allow the user to scroll through the list of bookmarked advertisements. One would have been motivated to include such a scrolling feature in

Art Unit: 3688

order to allow a large number of advertisements to be bookmarked and perused without running off the bottom of the screen.

Claim 15: Rice discloses a computer readable medium as in Claim 14 above, and further discloses the selected banner advertisement includes an HTML tag (column 3, lines 19-27).

Claim 16: Rice discloses a computer readable medium as in Claim 14 above, and further discloses outputting a button for display ("Bookmark" button) that, when activated, causes the display of the selected bookmarked advertisement (Figures 5 and 6; Abstract; and column 7, line 66 – column 8, line 7).

Claim 18: Rice discloses a computer readable medium as in Claim 14 above and further discloses the saved banner advertisement is associated with a tag (applet) in which the saving is based at least in part on the tag (column 6, lines 39-60).

Claim 19: Rice discloses a computer readable medium as in Claim 14 above, and further discloses displaying one or more navigational buttons as part of the graphical user interface (GUI) (Figures 5 and 6; and column 7, line 66 – column 8, line 7). While Next and Previous buttons are not explicitly disclosed by Rice, Official Notice is taken that these were both well known types of navigational buttons usually found on GUIs to enable the user to quickly go to the Next or Previous pages. Thus, it would have been

Art Unit: 3688

obvious to one having ordinary skill in the art at the time the invention was made for Rice to include Next and Previous buttons with the bookmark interface in order to allow the user to quickly and easily navigate between the saved advertisements.

Response to Arguments

9. Applicant's arguments filed July 8, 2010 have been fully considered but they are not persuasive.

The Applicant's arguments in reference to the scrolling feature have been addressed in the rejection above.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES W. MYHRE whose telephone number is (571)272-6722. The examiner can normally be reached on Monday through Thursday 6:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3688

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JWM

August 25, 2010

/James W Myhre/

Primary Examiner, Art Unit 3688